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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/721,617
Filing Date: November 25, 2003
Appellant(s): SANCHEZ ET AL.

MAILED
AUG 31 2007
GROUP 1700

Jeffrey A. Ruppel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 17, 2007 appealing from the Office action mailed 5-19-2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The examiner agrees with the summary of the subject as it is currently claimed in the instant application, however, the examiner disagrees with the applicants references to lines and pages of the original specification for support of the claimed subject matter as some of the claimed subject matter is not supported by the original specification, and thus is a subject to rejection under 35 USC 112, first paragraph.

Further, it is noted that in this section of the Appeal Brief, independent claims 9 and 20 are presented with "currently amended" identifier and those claims contain some text that is underlined (implying amended changes in the claims). However, claims 9 and 20 as presented in this section of Appeal Brief do completely correspond to the

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currently pending claims 9 and 20 as indicated in the Appendix. Therefore, the status identifier and the underlining of text is simply disregarded.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- 1 Claims 1,3-5,7-16,18-20 and 22-39 stand rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement.
2. Claims 1,3-5,7-16, 18-20, 22-30, 33 and 35-37 stand rejected under 35 USC 103 (a) as being obvious over US Patent 5,659,969 to Gerace et al., (hereinafter "Gerace") in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giesler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas").
3. Claims 31 and 39 stand rejected under 35 USC 103 (a) as being obvious over US Patent 5,659,969 to Gerace et al., (hereinafter "Gerace") in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giesler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas") and further in combination with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys.
4. Claims 32, 34, and 38 stand rejected under 35 USC 103 (a) as being obvious over US Patent 5,659,969 to Gerace et al., (hereinafter "Gerace") in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giesler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas"), and further in combination with US Patent 4,797,314 to Davey et al., (hereinafter "Davey").

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5. Claims 1,3,7-8,20,22, 25, 27-30 and 33 stand rejected under 35 USC 103 (a) as being obvious over SU 907036 (hereinafter "SE "036") in combination with US Patent 5,607,993 to Christy, (hereinafter "Christy") or US Patent 5,506,280 to Miller et al., (hereinafter "Miller") and further in combination with Giessler.

6. Claim 31 stand rejected under 35 USC 103 (a) as being obvious over SU 907036 (hereinafter "SE "036") in combination with US Patent 5,607,993 to Christy, (hereinafter "Christy") or US Patent 5,506,280 to Miller et al., (hereinafter "Miller") and further in combination with Giessler and further in combination with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys.

7. Claim 32 stand rejected under 35 USC 103 (a) as being obvious over SU 907036 (hereinafter "SE "036") in combination with US Patent 5,607,993 to Christy, (hereinafter "Christy") or US Patent 5,506,280 to Miller et al., (hereinafter "Miller") and further in combination with Giessler and further in combination with Dawey.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,658,969	Gerace	8-1997
5,607,993	Christy	3-1997
4,797,314	Davey et al	1-1989
3,627,707	Giessler et al	12-1971
3,917,550	Clas et al	11-1975

5,506,280

Miller et al

4-1996

A.. Nikiforov, "Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys", Morflex, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 1, 3-5, 7-16, 18-20, 22-39 are, rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 claims epoxidized soybean oil as a secondary plasticizer. While the specification discloses epoxidized soybean oil on line 12 of page 6, this component is disclosed as heat stabilizer, not the secondary plasticizer. Thus, there is no support for the claimed language "epoxidized soybean oil secondary plasticizer". Further, since epoxidized soybean oil is only disclosed as heat stabilizer, there is no support for the claimed ranges of this component as per claims 9 and 14, as the heat stabilizers are disclosed to be present in the amounts 1-2 %, not 1-3 % as claimed in claim 9. See last line on page 4.

Claim 20 recites a specific sequence of addition of the components in to the mixture reciting "adding rheology modifiers; and, thereafter adding and mixing

microspheres to said mixture”, which is in direct contrast to the originally claimed step sequence claiming adding rheology modifiers after the microspheres. Moreover, the original specification discloses that rheology modifiers are “finally” to the composition to give the composition the “final consistency” as per lines 14-15 on page 7. No other disclosure regarding the mixing step sequence can be found in the originally filed specification.

Claims 31 and 39 claim a compound, i.e., “acetyltributyl citrate” as the primary plasticizer, which compound is not disclosed anywhere in the specification by name or formula either directly or as incorporated by reference to another document. As such, the claimed limitation clearly constitutes new matter not supported by the original specification.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-5, 7-16, 18-20, 22-30, 33, 35-37 re rejected under 35 U.S.C. 103(a) as being unpatentable over under 35 U.S.C. 103(a) as obvious over Gerace in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter “Giessler”) or US Patent 3,917,550 to Clas et al., (hereinafter “Clas”).

First it is noted that the rejection set forth in the previous office action inadvertently omitted claim 1 from the heading of the rejection. However, it is clear from the body of the rejection that claim 1 was included in the rejection as clearly discussing all of the limitation of the very base claim 1, and further referring to in subsequent rejections.

As it appears from applicants' response, it was clearly understood that claim 1 is included in the rejection, thus the rejection of claim 1 does NOT constitute new grounds for rejection.

Gerace discloses a compositions comprising a PVC resin (column 1, lines 22-23, illustrative examples), a primary plasticizer, a stabilizer, microspheres and a rheology modifying filler such as aluminum oxide, talk, silica, etc., which are known thixotropic rheology modifying fillers. Various plasticizers disclosed in the reference, such as those disclosed in columns 16-17 and which include monomeric and polymeric plasticizers, are disclosed as usable alone (primary plasticizer) or in combination with one another (secondary plasticizer). The reference further expressly disclosed various stabilizers such as UV stabilizers, etc.in column 17, line 24 et seq. The illustrative examples further disclose addition of Interstab CZ, which is a zinc based heat stabilizer. See column 21, lines 49-50. The microspheres disclosed in "The Microspheres" section of the reference fully correspond to the claimed microspherres. Further, the glass microspheres are disclosed as suitable additives in column 18, lines 34-35, thus making use of an expressly disclosed component obvious for its intended function as a filler with reasonable expectation of sucess. The reference further expressly discloses suitability of dry expanded microspheres throughout the specification see, for example, column 7, lines 48-50. The relative amounts of all of the components disclosed in the illustrative examples and throughout the reference satisfy the claimed amounts.

The reference does not disclose suitability of the plastisol compounds to be used as modeling compounds, however, the limitation "modeling compound" is an intended

use limitation, this limitation is given weight only to the extent that the composition disclosed in the reference is capable of being used such. The disclosed composition is inherently capable for the claimed use because the claimed composition is believed to be identical to the composition disclosed in the reference, further based form the viscosity parameters of the compositions illustrated in the reference and also based on the description of the plastisol as "thck paste" in illustrative example 2. Therefore, the preamble limitation is anticipated by the reference. The burden to provide factual evidence to the contrary was shifted to the applicant , but no evidence was ever presented.

While the reference expressly discloses possibility and suitability of adding PVC plasticizers to the disclosed composition, the reference does not expressly exemplifies epoxidized soybean oil. . Epoxidized soybean oil is notoriously known plasticizer for PVC, and, thus, addition of epoxidized soybean oil to the PVC based plastisols would have been obvious for its known function with reasonable expectation of success as evidenced, for example, from the disclosures of either Giessler (see table IV, for example) or Clas (see, column, 4 lines 21-30, also listing other plsticizers such as dioctylphthalate that was used in illustrative examples of Gerace as functional equivalent of epoxidized soy bean oil).

The Gerace reference discloses stabilizers, including zinc based stabilizers used in illustrative examples. Moreover, zinc containing stabilizer, such as calcium zinc stabilizers are notoriously known in the art of PVC plastisols and would have been an obvious addition for its known function, as evidenced by, for example, Giessler, table III,

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claim 1. Insofar as the relative amounts of the components, the primary reference, Gerace, does not exemplified the claimed amounts, however, the reference discloses that conventional amount of additives in the PVC based plastisols are used. In this respect, conventional amounts of PVC in the plastisol compositions include the claimed amounts as, for example, evidence by claim 1 of Clas, tables III of Giessler and examples of the instant Gerace, and, therefore, choosing the amounts corresponding to the claimed amounts would have been obvious as conventional amounts absent showing of unexpected results that can be clearly attributed to the claimed amounts.

As the claimed compound to have less than .3 % of water, this limitation appears to be inherently met by the Grerace disclosed compositions. The Gerace reference does not address the water content limitation, however all of the components added to the disclosed compositions are dry components having virtually no water in it. Further, it appears that the applicants similarly use all of the commercially available components and do not use any special techniques or steps for removing water. In addition, the Gerace reference addresses the point of drying the microspheres and also possibility of adding water scavengers, thus implying tha no water is present in the compositions. Thus, the limitationto the amount of water si reasonable believed to be is inherently and necxessarily met by the disclosed plastisol compositions.

Insofar as the limitation of claim 20 requiring a particular sequence of adding components to the mixture, the Gerace reference does not specifically address the order of adding the components. Thus, to the extent that the reference does not specifically address the sequence of adding the components or exemplified a different

sequence of adding the components, the reference implies that any order of mixing is suitable for the invention. Moreover, it has been long established by the law that in the absence of unexpected results, selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930).

Claims 31 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giessler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas") as applied to claims 1 and 9 respectively, and further in combination with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys (submitted by the applicants).

The Gerace reference expressly discloses addition of various plasticizers to the PVC based plastisols, but does not expressly lists the claimed acetyltributyl citrate. The claimed plastisizer is a known plastisizer for PVC as evidence from the referenced article and as admitted by the applicants in their remarks. Thus, addition of a known plastisizer to the PVC based compositions of Gerace would have been obvious for its known plasticizing function with reasonable expectation success in obtaining expected cumulative results.

Claims 32, 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giessler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas") as applied to claims 1 and 9 respectively, and further in combination with US Patent 4,797,314 to Davey et al., (hereinafter "Davey").

The Gerace reference expressly discloses addition of various thixotropic additives to the PVC based plastisols, but does not expressly lists the claimed organophilic clay. The claimed additive is a known thixotropic agent for PVC as evidence from the Davey (column 3). Thus, addition of a known thixotropic to the PVC based compositions of Gerace would have been obvious for its known function with reasonable expectation of adequate results.

Claims 1,3, 7-8, 20, 22, and 25, 27-30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU 907036 (hereinafter "SE '036") .in combination with Christy or Miller and further in combination with Giessler.

The SU '036 reference discloses modeling compositions comprising PVS, two-components plasticizer comprising the primary (dioctylphthalate) and secondary (CaO) plasticizer, a stabilizing wax and a filler such as kaolin or talk. The amounts of all of the components and their ranges disclosed in the reference overlap with the amounts claimed in claims 27-30 (see, for example, bottom of column 2). Choosing any amounts from the disclosed ranges, including those corresponding to the claimed amounts, would have been obvious absent showing of unexpected results that can be clearly attributed to the claimed amounts. The reference does not disclose any additional filler, however, adding microsphere filler to a polymeric composition (containing virtually any base thermoplastic polymer) is notoriously known in the art to reduce the polymer matrix density and to improve other properties of the polymeric matrix. This positions is supported by the disclosure of Christy or Miller, for example, expressly disclosing that addition of microspheres would have a predicted impact on

the properties of the base polymeric matrix. See Christy, Figure 1, column 4, lines 35-47, and Miller column 4, lines 30-59. Thus, addition of microspheres to the compositions disclosed in SU '036 would have been obvious to reduce the density of the modeling compound disclosed in the SU reference, and the amount of the microsphere filler can be varied depending on the desired final density and other properties.

While disclosing various plasticizers and their amounts, the reference does not expressly lists epoxidized soybean oil as a suitable plasticizer. However, epoxidized soybean oil is notoriously known plasticizer for PVC, and, thus, addition of epoxidized soybean oil to the PVC based plastisols would have been obvious for its known function as evidenced, for example, from the disclosures of Giessler, claims, table III. Similarly, while stabilizers are disclosed in the SU reference, specific zinc containing stabilizers are not disclosed. However, zinc containing stabilizer, such as calcium zinc stabilizers are notoriously known in the art of PVC plastisols and would have been an obvious addition for its known function, as evidenced by, for example, Giessler (see table IV, for example) and with reasonable expectation of adequate results.

As to the limitation for the claimed compound to have less than .3 % of water, this limitation appears to be inherently met by the disclosed compositions. The SU '036 reference does not address the water content limitation, however all of the components added to the disclosed compositions are dry components having virtually no water in it. Moreover, the initial treatment of the composition includes heating it to substantially high

temperatures further assuring evaporation of any residual water is such is present. In addition appears that the commercially available components used in the reference correspond to the components listed in the instant application and the instant application does not indicate that any additional steps are required to reduce the water amount other than using components that do not contain water. Thus, the limitation of water content is reasonable believed to be inherently and necessarily met by the disclosed modeling compositions.

Insofar as claim 20, while the primary references may disclose a different order of adding the claimed components, it has been long held by the court that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. See *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946); or *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.). Thus the claimed process would have been obvious from the combined teachings of the above cited references.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over SU 907036 (hereinafter "SE "036") in combination with Christy or Miller, Giessler and further in combination with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys (submitted by the applicants).

Addition of the claimed plasticizer to compositions of SU would have been obvious for the same reasons as its addition is obvious to the composition of Gerace discussed above.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over SU 907036 (hereinafter "SE "036") in combination with Christy or Miller, Giessler and further in combination with Davey.

Addition of the claimed thixotropic agent to compositions of SU would have been obvious for the same reasons as its addition is obvious to the composition of Gerace discussed above.

(10) Response to Argument

The applicants argue that the rejection of claims under 35 USC 112, first paragraph is erroneous as the specification provides support for the claim language. Specifically, the applicants state that "Support for epoxidized soybean oil being used as a heat stabilizer can be found on page 6, line 12 and one of ordinary skill in the art would have understood that epoxidized soybean oil could also be used as a secondary plasticizer."

The referenced part of the specification, indeed, discloses epoxidized soy bean oil, and indeed, discloses it as a heat stabilizer, not a plasticzer, and, especially not as a secondary plasticizer, as claimed in claim 1. It is noted that primary palsitizers are disclosed on page 5, lines 23-29, and exemplified simply as "monomeric or polymeric plasticizers". On pages 30-33, secondary plasticizers are disclose a being present in small amounts. No specific examples and no specific amounts are provides, however a statement that the secondary plasticizer need not be present at al is provided on lines 31-33 of page 5.

The applicants further state that "Epoxidized soybean oil has common and widespread industrial uses as both a plasticizer and heat stabilizer by the polymer industry. One skilled in the art would reasonably conclude that the inventor, by mentioning epoxidized soybean oil for use as a heat stabilizer, also contemplated its use as a secondary plasticizer. As the examiner admits: "[e]poxidized soybean oil is [a] notoriously known plasticizer."

While the examiner agrees that the claimed epoxidized soy bean oil is a notoriously known plasticizer in the art of PVC compositions, the support for the claimed invention, especially in combination with the claimed amounts in claims 9 and 14 must be provided in the applicants own specification and not inferred from the general knowledge in the art. The applicants, as discussed above, provided no support for the claimed compound in the claimed capacity and the claimed amounts anywhere in their own specification. Thus, the claims fail to comply with the written description requirement.

The applicants further argue that support for the recitations of claim 20 of a specific smixing step sequence, i.e., "adding rheology modifiers; and, thereafter adding and mixing microspheres to said mixture" can be found on page 7, lines 8-15; Paragraph 32 (wherein "overmixing after the addition of microspheres must be avoided"). By indicating in the description that "overmixing after the addition of microspheres must be avoided", it is inherently disclosed that microspheres should be added to the mixture after the other ingredients. One skilled in the art, having heard that overmixing was to be avoided, would reasonably conclude that the inventor had

possession of the need for the microspheres to be added and mixed after adding the rheology modifiers."

This statement by the applicants directly contradicts the explicit disclosure of their own specification on page 7, lines 14-15 expressly stating that the rheology modifier is added "Finally... to give the clay final consistency". It is also noted that this statement follows the phrase "overmixing after the addition of microspheres must be avoided" relied upon by the applicants for support for adding the rheology modifier to the composition prior to addition of microspheres. This disclosure clearly implies that the "overmixing" discussed in lines 8-15 of page 7 refers to the mixing on the composition prior to adding the rheology modifier. Finally, the original claims 20 clearly claim addition of rheology modifier subsequent to the addition of microspheres, further supporting the examiners position that nowhere in the specification the now claimed mixing order is supported explicitly or implicitly.

In arguing the rejection of claims 31 and 39 (reciting a specific compound, i.e., "acetyltributyl citrate" as the primary plasticizer) as claiming subject matter that is not supported by original specification, the applicants argue that the specifically claimed chemical compound is supported by the generic disclosure of "primary plasticizers" in the specification and that the specific compound would be known by an ordinary artisan as a plasticizer. The applicants provided an external document that shows that, indeed, the claimed chemical compound, i.e., "acetyltributyl citrate", is a known plasticizer. But so are thousands and thousands of other compounds. The bottom line is that nowhere in the specification the claimed compound is mentioned as a part of the instantly

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claimed invention, and no evidence can be found in the original specification that the claimed compound or any other specific chemical compound that may be generally known in the art for a specific function was intended to be used, or was used by the applicants or the applicants were in the possession of the composition that utilize the specifically claimed chemical compound.

In arguing rejection of claims 1, 3-5, 7-16, 18-20, 22-30, 33, 35-37 as obvious over Gerace in combination with Giessler or Clas, the applicants state that none of the cited references contain a motivation to combine the cited references. This is simply not so. First of all, as noted in the KSR decision quoted by the applicants, the motivation to combine the references does not have to be found strictly in the cited references. But more importantly, the examiner specifically pointed out where the motivation to combine references can be found. Specifically, the primary reference, Gerace, as discussed above, while expressly disclosing suitability to add plasticizers and stabilizers to the plastisol compositions disclosed in the primary reference, does not disclose any particular plasticizers or stabilizers by their chemical names, thus implying that any known additives with those functional properties are suitable for the invention with reasonable expectation of success. The secondary references were cited as evidence that the specifically claimed plasticizers and stabilizers are, indeed, known plasticizers and stabilizers for the PVC based compositions. Expectation of success by using known compounds for its functional properties is the motivation to use such known compounds as evidenced by the secondary references.

The applicants further argue that use of the primary reference, i.e., Gerace is improper as it is directed to a plastisol and not modeling compound. The claimed limitation of "modeling compound" is a mere recitation of an intended use of the claimed composition. As such this limitation is only given weight to the extent that the disclosed compositions can be used for the claimed use. "Plastisols are formulations of thermoplastic polymers and plasticizers therefor, characterized by the fact that the components of the formulation can be combined, heated to form a homogeneous sol or solution of the resin in the plasticizer, and then cooled to a temperature at which a phase inversion occurs to produce the resin with the plasticizer homogeneously dissolved or dispersed therein." See definition in Gerace, column 1, lines 15-21. It can be used for wide variety of applications, and, since the consistency of the plastisols are of thick paste (as for example described in examples of Gerace), it can be used as a "modeling" compound. The bottom line is, the instant claims are directed to a composition that is intended to be used a modeling compound. The primary reference discloses similar compositions that can be used for the claimed intended use, thus the primary reference was properly used in the rejections of the claimed compositions as concerning similar polymeric compositions, regardless of their final use.

The applicants further argue that the Gerace reference does not address all of the claim limitations by not specifying the amount of water in the disclosed PVC composition. As discussed above, the examiner agrees that the Gerace reference does not expressly address the amount of water in the composition, however, as

discussed above, this limitation is believed to have been inherently met by the disclosed compositions.

In arguing rejection of claims 20 and 22-30 as obvious, the applicants state that claim 20 provides more than just a random order of mixing. The applicants argue that "it is important to avoid overmixing of the microspheres. Applicant realized this need and developed a process for forming and an order of mixing the modeling compound to overcome this problem. The order of mixing presented in claim 20 is not just an arbitrary order, it has a purpose and is therefore not obvious."

Those argument are simply contradictory to the original disclosure, as discussed in the section concerned with claim support. While applicants may have realize importance of not overmixing the microspheres, and may have developed a process for overcoming this problem, contrary to their statement applicants did NOT develop a process that correspond to the claimed order of mixing steps. Not only the process as claimed in not disclosed as important step sequence, it is NOT disclosed in the specification at all, and addition of rheology modifier prior to addition of microspheres is not disclosed as overcoming a specific problem or as an important sequence step.

The applicants further argue that use of Davey reference in rejecting claims 32, 34 and 38 is improper as the reference is concerned with surface covering compositions, not modeling compounds. The Davey reference was used in the rejection to provide specific examples of thixotropic agents commonly used in PVC based composition. The main reference, Gerace, discloses thixotropic agents generically, but not specifically. Thixotropic additives are simply viscosity modifiers, and

their function is un-changed whether used in PVC based compositions intended for one or another use. Thus, the Davey reference disclosing specific thixotropic agents suitable for PVC based compositions and their known function was properly used in combination with the primary reference.

The applicants further argue that rejection of claims 1, 3, 6-8, 20, 22, 25, 27-30 103(a) as obvious over SU 907036 (hereinafter "SU '036") in combination with either US Patent 5,607,993 to Christy (hereinafter "Christy") or US Patent 5,506,280 to Miller et al. (hereinafter "Miller"), and further in combination with Giessler. Is improper as use of Giessler is reference is improper as discussed by applicants in their arguments for Grounds for rejection 4. This argument of propriety of using Gerace reference is addressed above. Moreover, this reference was used in combination with SU '036 for its disclosure of known plasticizers for PVC. The plasticizer for PVC is a plasticizer regardless of the form of the composition and its function of plasticizing the base polymer does not change regardless of the actual physical form (even if, such difference exist which it does not between plastisol and "modeling compound") of the PVC based composition. The applicants argue that use of Christy is also improper, as it is directed to a bouncing putty, not a modeling compound. The answer to this argument is similar to the previous answer, use of Christy is proper as it discloses composition similar to the ones disclosed in the primary reference, SU '036.

The applicants argues that the SU reference does not teach specific amounts of PVC, and the Christy and Miller references do not disclose the claimed amounts of PVC. In response , it is noted that the claims that specifically recite PVC amounts

(claim 9, etc) are NOT rejected under this rejection. Thus, the arguments presented by the applicants are simply irrelevant to the rejected claims.

The applicants further argue that Miller teaches away from the present invention as it discloses compositions having high water content. Once again, it is noted that the disclosure of Miller was relied upon only for support of known additives, namely polymeric microspheres to a polymeric matrix to reduce the overall density of the composition, which function does not depend on the form or amount of other non-reactive components in the composition. Thus, the actual amounts of components in the compositions disclosed in Miller are irrelevant, as this was not the teaching relied upon in using this reference. The microspheres still behave as density reducers in various polymeric compositions regardless of water content of the polymeric compositions.

The applicants further argue that claim 31 is improperly rejected under SU 907036 (hereinafter "SU '036") in combination with either US Patent 5,607,993 to Christy (hereinafter "Christy") or US Patent 5,506,280 to Miller et al. (hereinafter "Miller"), and further in combination with Giessler and further in combination with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys. No new arguments are presented under this heading (Ground 8). It is, however, noted that claim 1 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace in combination with either US Patent 3,627,707 to Giesler et al., (hereinafter "Giessler") or US Patent 3,917,550 to Clas et al., (hereinafter "Clas") as applied to claims 1 and 9 respectively, and further in combination

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with Preliminary Risk Characterization for Acetyl Tributyl Citrate Used as a Plasticizer in Polyvinyl Chloride Children's Toys, for which rejection no arguments is presented.

Similarly, no separate arguments are presented for the rejection of claim 32 under SU 907036 (hereinafter "SU '036") in combination with either US Patent 5,607,993 to Christy (hereinafter "Christy") or US Patent 5,506,280 to Miller et al. (hereinafter "Miller"), and further in combination with Giessler and further in combination with Davey.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Irina S. Zemel



Conferees:


Romulo Delmendo,
James J. Sedleck